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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Robert Cobene et al.) Group Art Unit: 3722
Application No.: 10/697,037) Examiner: Eric Andrew Gates
Filed: October 31, 2003) Appeal No.: _____
For: SERIAL METHOD OF BINDING A)
TEXT BODY TO A COVER)
)
)
)

REPLY BRIEF

Mail Stop APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's Answer dated June 19, 2008, wherein the 35 U.S.C. §102(e) rejection of claim 1 is maintained. The Examiner's "Response to Argument" on pages 11-12 of the Answer addresses Appellant's claim 1 recitation of a sheet "contacting surface" which makes "line contact" with a cover (e.g., a book cover), and asserts in the sentence bridging pages 11-12 that:

This argument [by Appellant] is not persuasive because there is nothing in Appellant's claim 1 that requires that the contacting surface, which is defined as the surface to which the adhesive is applied, must only be formed on a single side or edge of the sheet. The claim also does not prevent different portions of the contacting surface from being used to define the line contact with the cover and the non-zero contact angle of the adhesive.

NEW ISSUE:

The Examiner's assertion that "nothing in Appellant's claim 1" requires that the contacting surface ... must only be formed on a single side or edge of the sheet" constitutes a new issue.



The Examiner's new assertion is erroneous as it ignores Appellant's claim 1 recitation of "adhering" a sheet to the cover by "line contact" (e.g., Appellant's Fig. 5) as opposed to by multi-plane contact (Fig. 8 of the Lawton patent document). Appellant's claim 1 specifically recites that adhesive is applied to a "contacting surface". Claim 1 recites that the adhesive applied to "the contacting surface" forms a non-zero contact angle with the contacting surface. Importantly, it is "the" contacting surface to which the adhesive has been applied that makes "line contact" (not multi-plane contact) with the cover.

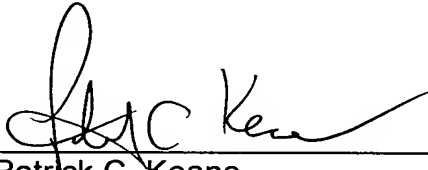
In Fig. 8 of the Lawton document, adhesive 110, 112, 114 is applied to multiple sides of each sheet. The multi-planar contacting surface disclosed by Lawton can **not** make "line contact" with a cover as presently claimed. Any "adhering" feature of Lawton is achieved by **making multi-planar contact**, not line contact, with a cover. Appellant's claim 1 is therefore allowable.

As such, the Examiner's 35 U.S.C. §102(e) Final Rejection of Appellant's claim 1, and all claims which depend therefrom, should be reversed.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date August 19, 2008

By: 
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703 836 6620



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